Applicant maintains traversal of this rejection. The generic compound held to anticipate Applicant's single species of Claim 5 is the compound of formula I of Application No. EP 302,644 ("Compound I"). Compound I has four variable groups: R_2, R_3 and two of R_1. The Examiner has constructed a subgeneric compound within the scope of Compound I, allegedly from preferred definitions of R_1, R_2 and R_3 in the specification of EP 302,644, which has been held to anticipate Applicant's Claim 5. Applicant submits that the subgeneric compound constructed by the Examiner is an invalid hindsight reconstruction of the prior art using Applicant's own disclosure as a guide, and such constructed subgeneric compound is not within the guidelines of In re Petering 133 USPQ 275; In re Sivaramarishnan 213 USPQ 441; and In re Schaumann 197 USPQ 5.

It is stated in the rejection that "R_3 as amino is clearly preferred, as it is the sole choice seen in the final product." (Final Rejection, page 2)

This is incorrect. For the final compound of EP 302,644 (i.e., Compound A), amino is clearly preferred - in fact it is required - but in the context of Compound I or Compound II, synthetic intermediates for preparing Compound A, no such teaching exists. On page 7, lines 12-13, of EP 302,644, it is stated that :

> Suitable values for R_3 when a protected amino group include C_{2-5} alkanoylamino such as acetylamino or pivaloylamino, aroyl such as benzoyl, and arylmethyl such as benzyl.
>
> Values for R_3 in compounds of formula (I) include amino, halogen for example chlorine, and protected amino such as C_{2-5} alkanoylamino, for example acetylamino.

Further, on page 6, lines 51-54, of EP 303,644, converting R_3 to amino is disclosed as a particular embodiment. Nowhere does EP 303,644 teach that amino is preferred, only that having R_3 as amino in Compound I is one way to arrive at Compound A.

There may be many reasons why substituents other than amino for R_3 may be preferred, e.g., as described in Applicant's Response of July 31, 2001, a skilled artisan may consider the presence of an amino group in a chemical intermediate that is going to undergo further conversion as undesirable, as it may be readily amenable to undesirable chemical modification in a later reaction. If anything, EP 303,644 in the passage quoted above teaches that protected amino is preferred.

Regarding R_1 of Compound I, methyl and ethyl are the only moieties named, but are not indicated as preferred, they are listed as merely examples. C_{1-4} alkyl includes methyl, ethyl, n-propyl, iso-propyl, n-butyl, iso-butyl, sec-butyl, and tert-butyl.

Regarding R_2, Applicant reiterates his position that page 7, lines 8-9, of EP 302,644 teach substantially more than two possibilities.

It is submitted that the Examiner has reconstructed the teachings of EP 303,644 using Applicant's disclosure as a guide to arrive at a subgeneric compound not disclosed in the art. Such "picking and choosing" as done by the Examiner is impermissible. (In re Arkley 172 USPQ 524) In fact, if one were to follow the teachings of the working examples of EP 303,644, not only would Applicant's Claim 5 not be anticipated, but it would be impossible to arrive at such a compound because the examples teach removal of the 6-chloro prior to decarboxylation.

Claims 5-7, 10-14, and 21 stand rejected under 35 USC 103(a) as being unpatentable over Application No. EP 302,644.

Applicant's claimed method comprises a specific sequence of steps simply not taught or suggested by EP 302,644. The sequence claimed herein involves coupling, decarboxylation, reduction, and esterification, followed finally by removal of the 6-chloro substituent.

Even assuming, arguendo, that EP 302,644 renders Applicant's claimed process *prima facie* obvious, Applicant has submitted more than adequate evidence in Applicant's specification (specifically on pages 5 and 6) the previously submitted Geen Declaration, and the previously submitted Jones Declaration to rebut such a *prima facie* case.

In particular, the Jones Declaration unequivocally shows that unexpected results are achieved by retention of the 6-chloro throughout the claimed process. The Examiner cites several differences in the procedures described in EP 302,644 and in the procedures followed in the Jones Declaration. The Examiner is reminded that what is required as convincing evidence of unobviousness and unexpected results in a given situation depends entirely upon the proposition sought to be proved by that evidence. (In re Yan 175 USPQ 96). The experiments performed in the Jones Declaration were designed to determine the significance of the continued presence of

the 6-chloro substituent during carboxylation and through the final step. The proposition sought to be proved does not require an exact duplication of the examples of EP 302,644 in the most minute detail. The Jones Declaration compares two routes to the desired product which differ only in that one removes the Cl prior to decarboxylation as in EP 302,644 and the other removes the Cl after decarboxylation as in the present invention.

Dr. Jones, an expert in the art, concludes in paragraph 9 of his declaration that his "experimental data confirm that the continued presence of the 6-chloro substituent during decarboxylation and through the first step of the process is responsible for the advantages of the process of '926 over that described in '644 rather then (sic) the particular reaction conditions employed..." Such a statement is an opinion of an expert interpreting data. If the Examiner has personal knowledge that the opinion of Dr. Jones is incorrect, it is requested that an affidavit be filed pursuant to 37 CFR 1.104(d)(2).

Regarding the nonobviousness of the compound of Claim 5, as stated earlier, it would be impossible to arrive at such compound following the teachings of Application No. 302,604. Therefore, 35 USC 103 compels a conclusion of nonobviousness.

It is submitted that Applicant's specification and claims are in proper form. Applicant requests that the rejection of the claim under 35 USC 102(b) and 103(a) be withdrawn and that pending Claims 5-7, 10-14, and 21 be passed to allowance.

Respectfully submitted,

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